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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,030	03/02/2001	Horst Hintze-Bruning	IN-5453	7425

7590

12/16/2002

Basf Corporation  
26701 Telegraph Road  
Southfield, MI 48034-2442

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 12/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

1

A3-11

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/762,030		HINTZE-BRUNING ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Lawrence D Ferguson		1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9/10</u> . | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed October 7, 2002.

Claims 5, 12 and 17 were canceled and claim 1 was amended rendering claims 1-4, 6-11 and 13-16 pending.

***Claim Rejections: 35 USC 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4, 6-8, 10, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In Claim 1, the phrase, 'flexible enough to be rolled up' is indefinite. 'Flexible enough' is indefinite because it lacks a requisite degree. It is unclear how flexible the film is.

b. Claim 14 is dependent upon claim 5, which has been canceled. Correction is required.

***Claim Rejections – 35 USC § 103(a)***

4. Claims 1-4, 6-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0844286 in view of Craun et al (U.S. 6,184,281).
5. EP '286 discloses filmed powder coatings for substrates made of plastics (abstract) where the coatings are dry and free flowing (page 2, line 17) and have a melt temperature of 200 F (93.33°C) (page 2, lines 44-47). EP '286 discloses thermally cured powder coatings comprising a crosslinker (page 4, lines 36-53) which is a surfacer composition. The reference discloses the coatings as molten film over the substrate with coatings having a thickness of 25 micrometers to 254 micrometers (page 11, lines 21-41) where the substrates are used as furniture (page 12, line 10), which are domestic appliances. EP '286 does not disclose thickness of the substrate. The thickness of the substrate is an optimizable feature as it controls the flexibility of the film. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves routine skill in the art see *In re Boesch*, USPQ 215 (CCPA 1980). EP '286 does not disclose removable film. Craun teaches a coating composition suitable for coating plastic substrates where the coatings are easily removable (abstract) where the coatings can be powder coatings (column 2, line 30). EP '286 and Craun are analogous art because they are from the same field of coated substrates. It would have been obvious to one of ordinary skill in the art to include the removable coating (film) to at least one powder coating layer of EP '286

because Craun teaches the removable coatings are recyclable (abstract) and are therefore environmentally safe.

### ***Response to Arguments***

6. Rejection made under 35 USC 112, second paragraph, is withdrawn due to Applicant canceling claims 12 and 17. Rejection made under 35 USC 102(b) as being anticipated by Leach (U.S. 5,338,578) is withdrawn due to Applicant's amendment of claim 1 incorporating limitations of cancelled claim 5. Additionally, rejection made under 35 USC 103(a) as being unpatentable over Leach (U.S. 5,338,578) is withdrawn due to Applicant's amendment of claim 1 incorporating limitations of cancelled claim 5.

Rejection made under 35 USC 103(a) as being unpatentable over Leach (U.S. 5,338,578) in view of Craun et al (U.S. 6,184,281) is withdrawn due to Applicant's amendment of claim 1 incorporating limitations of cancelled claim 5.

Rejection made under 35 U.S.C. 102(b) as being anticipated by EP 0844286 is overcome due to Applicant amending claim 1 to include 'a film flexible enough to be rolled up' Rejection made under 35 USC 103(a) as being unpatentable over EP 0844286 in view of Craun et al (U.S. 6,184,281) has been considered but is unpersuasive. Applicant argues EP '286 does not disclose coated films which can be rolled up and have a support layer having a film thickness of from 10 to 1000 micrometers. . The reference discloses the coatings as molten film over the substrate with coatings having a thickness of 25 micrometers to 254 micrometers (page 11, lines

21-41). The thickness of the substrate is an optimizable feature as it controls the flexibility of the film. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves routine skill in the art see *In re Boesch*, USPQ 215 (CCPA 1980). Applicant argues EP '286 teaches a hard inflexible substrate and is silent as to any need for flexibility. Examiner respectfully disagrees that EP '286 teaches a hard inflexible substrate. There is no place in the prior art of EP '286 that teaches a hard inflexible substrate. Furthermore, Applicant claims a film flexible enough to be rolled, and argues in the response the film is capable of being rolled. The film of EP '286 is also has the capability of being rolled, absent any evidence to the contrary.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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